

On page 2 of the Advisory Action, it is said that Applicant's prior response argues the Application's perceived advantages, and that such perceived advantages are not disclosed within the claim. Further, in response to Applicant's statement that the Examiner appears to be simply picking fragments of disclosures from the references such as Savitch without any relation to the problems to be solved by the invention, advantages that can be attained by the invention, and so forth, it is said that the Examiner disagrees with such assessment. In this connection, it is said that the Savitch reference teaches a program structure, written in C++, to display text in a two-dimensional array on a display screen. Further, the Sedgewick reference is said to disclose the allocation of a two-dimensional array, written in C++, and further discloses storing data within the two-dimensional array. As stated in the Final Office Action, it is again noted that it would have been obvious to one of ordinary skill in the art at the time of the invention to have combined Savitch's method of text indexing and display, disclosed as a two-dimensional data structure written in C++, with Sedgewick's method of storing text in memory, in a two-dimensional data structure written in C++, since it would have allowed a notational convenience to programs in referring to text, as disclosed by Sedgewick on page 116, paragraph 1 thereof.

First of all, regarding the statement in the Advisory Action that "the perceived advantages are not disclosed in the claim", this appears to be contrary to long-established practice with respect to claim drafting inasmuch as the advantages of an invention should be described in the specification and not in the claim. In this connection, see page 871 of Section 315 of Deller's "PATENT CLAIMS", a copy of which is enclosed. On that page, the decision in Ex parte Schweitzer, 1901 CD 179, is quoted in which a clause of a claim is said not to convey an idea of structure but "is a mere statement of some advantages which the applicant thinks would flow

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Reply to Office Action of August 8, 2005

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from the use of his device". As further stated after that, "The advantages of the use of the device should be described in the specification, not in the claims".

And as further stated on page 46 of Section 26 of Deller's "PATENT CLAIMS", the decision in Hollingshead v. Bassick, 73 F.2d 543 (CA6) is quoted as stating "Claims must be interpreted in the light of the specification as though the words 'substantially as described' were incorporated in each claim and should be limited to this contribution, which is the invention disclosed by the patent. (emphasis added)" A copy of this page is also enclosed.

Also enclosed is a copy of page 353 of Section 396 of Deller, wherein it is stated "All patentable inventions are defined by the claims, but described, explained and disclosed by the specification. (emphasis added)"

Also enclosed is a copy of page 9/13 of the decision by the CAFC in PSC Computer Products, Inc. v. Foxconn International, Inc., et al., 03-1089, (decided January 20, 2004), wherein it is stated "One of ordinary skill in the art should be able to read a patent, to discern which matter is disclosed and discussed in the written description, and to recognize which matter has been claimed. (emphasis added)"

Thus, the term "disclosed" is used with reference to the specification and not with reference to the claims. Applicant's perceived advantages over the cited references are nothing but advantages and do not constitute claim limitations. As such, the advantages should not have to be "disclosed" (or included) in the claim before an applicant can emphasize such advantages in its arguments. The Examiner's comments hold true only with respect to "limitations" (not advantages), which are suitable for forming constituting elements of a claim.

Regarding the repeated rejection based on the combination of Savitch and Sedgewick, Applicant's arguments set forth under the "REMARKS/ARGUMENTS"

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section of the Response of July 20, 2005 have not been addressed, with respect to the teaching-suggestion-motivation test. The references do not provide adequate motivation for combining them. In this connection, the Final Office Action refers to pages 610 and 611 of Savitch as disclosing, among others, the last step of "selecting one of said L candidate processing matrices as a processing matrix, and then determining characters contained in said processing matrix as processing characters". However, the last step of "selecting and determining" of the present invention is described in many parts of the specification, such as on page 35, line 16 through page 38, line 39. The specific processing of "selecting (and determining)" as described above and as set forth in claim 1, for example, does not appear to be disclosed in Savitch. Such reference seems to have only disclosed the allocation of a two-dimensional array in connection with programming. The description is made therein without any relation at all to the "problems" pointed out in the case of the present invention.

This also applies to Sedgewick. When the references have no disclosure whatsoever of the problems to be solved by the invention, how can a person skilled in the art be motivated to combine them together? Even if the two references have been combined together, there cannot be obtained the present invention as claimed because such references do not disclose the series of steps (particularly the last step in the case of claim 1).

In view of this, claims 1-23 are again submitted to clearly distinguish patentably over the attempted combination of Savitch and Sedgewick and the further combination of those two references with Nunokawa. Reconsideration and allowance are respectfully requested.

If for any reason the Examiner finds the application other than in condition for allowance, the Examiner is requested to call the undersigned attorney at the Los

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Angeles, California telephone number (213) 337-6846 to discuss the steps necessary for placing the application in condition for allowance.

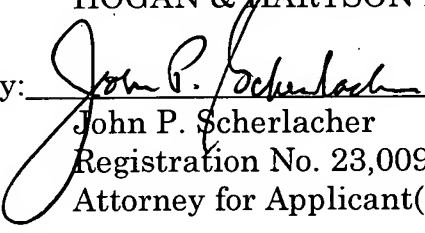
If there are any fees due in connection with the filing of this response, please charge the fees to our Deposit Account No. 50-1314.

Respectfully submitted,

HOGAN & HARTSON L.L.P.

Date: October 13, 2005

By: _____


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closed'; but 'any claim which is broader than the described invention is void; even where that invention is valuable, and could have supported a valuable claim.' Walker on Patents (4th ed) Section 117, citing Edison v American Mutoscope Co., 114 F 934, 52 CCA 546.

"The concept contained in the description of the letters patent before us is a curtain-stretcher, the bars of which, when folded, will lie in the same plane. That concept runs through the whole description. Both the advantage of the invention and its mode of operation are confined to that concept. 'By reason of the fact that they lie in the same plane,' says the description, 'both sets will be held against unfolding without any other fastening means.' Now, the stretcher actually put upon the market, different from this, is clearly an afterthought. And the mere omission of the words 'adapted to fold in the same plane,' in the claims sued upon, cannot be held to show a concept different from the one to which the description is confined."

§ 315. CLAIM SHOULD NOT SPECIFY THE ADVANTAGES TO BE DERIVED FROM THE USE OF THE INVENTION

The chief reason for barring references in the claims to the over-all result or advantages obtained by the use of the invention, is that a statement of such result or advantages does not change the form or composition of the component parts. This was clearly expressed in Ex parte Schweitzer, 1901 CD 179, where Commissioner Allen stated:

"The clause of claim 1 objected to is as follows:
'whereby the working surface, time and power employed is reduced to a minimum.'

"This clause clearly conveys no idea of structure, but is a mere statement of some advantages which the applicant thinks would flow from the use of his device. The purpose of the claim is not, under the law, to embody such statement, but is to set forth the structure which is regarded as the applicant's invention. The advantages of the use of the device should be described in the specification, not in the claims. The inclusion of this clause in claim 1 does

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PATENT CLAIMS

by the resiliency and retardation of the springs of the standard washer preserved."

In *Hollingshead v Bassick*, 73 F2d 543 (CA6), 24 USPO 195, aff'd 298 US 415, 80 L ed 1251, 56 S Ct 787, the Court stated:

"Claims must be interpreted in the light of specifications as though the words 'substantially as described' were incorporated in each claim and *should be limited to this contribution, which is the invention disclosed by the patent.*" (Author's Italics.) ←

§ 26. WHERE TERMS ARE INDEFINITE THE SPECIFICATION IS RESORTED TO FOR ELUCIDATION

Resort to the specification to determine the meaning of the terms used in the claims is expressly approved by Rule 75(d) which reads as follows:—

"The claim or claims must conform to the invention as set forth in the remainder of the specification and the terms and phrases used in the claims must find clear support or antecedent basis in the description so that the meaning of the terms in the claims may be ascertainable by reference to the description."

In *B. B. Chemical Co. v Cataract Chemical Co., Inc.*, 122 F2d 526 (CA2), 50 USPQ 530, claim 2 of the patent in suit called for a "high" viscosity softener.

With reference to such claim, Judge Chase stated:

" . . . And unless the word 'high' has an accepted meaning in the art or is defined in the specifications, claim 2 is left too vague to be valid. Moreover, claims 1, 19, 20 and 21 also are tied to the term 'high viscosity nitrocellulose' or 'high viscosity cellulose derivative.' The trial court found on somewhat disputed, but clearly sufficient, evidence that the art knew no definite meaning for the expression 'high viscosity' as applied to nitrocellulose. We must, therefore, turn to the specifications to find whether Wedger there defined these expressions used in his claims."

OPERATING CONDITIONS IN PROCESS CLAIMS. § 396

"All patentable inventions are defined by the claims, but described, explained and disclosed by the specification."

In other words, claims measure the invention and claims define the metes and bounds of the boundary lines surrounding the patent grant. On the other hand, the specification embodies a disclosure of an invention.

In Ex parte Hanley et al, 77 USPQ 237, main claim 35 reads as follows:

"In the method of electrowinning manganese wherein an ordinary electrolyte of manganese and ammonium sulphates is electrolyzed in a diaphragm cell under ordinary conditions whereby the current efficiency is greater than 50 percent, the improvement which is characterized by employing an anode of lead allowed with one to three percent silver and of less surface area than the cathode; initially operating the cell at an anode current density much higher than the customary current densities in such cells and exceeding the cathode current density due to the difference in their areas, while maintaining the current efficiency above fifty percent; initially depositing a protective film on the anode under said operating conditions for a period of about 24 hours; and continuing the electrolysis under said operating conditions for a period of about 2 weeks to form a scale composed principally of oxides of manganese and lead on the anode and reduce the manganese deposited, as oxide, on the anode to less than one percent of the metal deposited on the cathode."

The rejection of the claim was sustained by the Board of Appeals as the claim did not definitely specify the operations and steps in a proper manner. In its discussion, the Board said that:

"This leaves the other ground of rejection on indefiniteness for consideration. The appealed claims recite, for instance, 'an ordinary electrolyte', 'under ordinary conditions', etc. The examiner has held these recitations objectionable on the ground that the process for electrowinning manganese has not been standardized. Irrespective of whether the process has been standardized or not, a claim must be definite to comply with that degree of par-

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In essence, the written description can, at times, assist the public in understanding the notice given in the claims by explaining which portions of the relevant art the patent does not cover. Scimed, 242 F.3d at 1341. To quote an oft-repeated phrase: "Specifications teach. Claims claim." SRI Int'l v. Matsushita Elec. Corp., 775 F.2d 1107, 1121 n.14 (Fed. Cir. 1985). "Consistent with its scope definition and notice functions, the claim requirement presupposes that a patent applicant defines his invention in the claims, not in the specification. After all, the claims, not the specification, provide the measure of the patentee's right to exclude." Johnson, 285 F.3d at 1052.

Suitable notice to the public, however, requires that the public understand the language of both the claims and the written description. We have repeatedly explained that, in the absence of a compelling reason to do otherwise, claims must be interpreted as one of ordinary skill in the art would understand them. See, e.g., Apex Inc. v. Raritan Computer, Inc., 325 F.3d 1364, 1371 (Fed. Cir. 2003) ("In analyzing the intrinsic evidence we start with the language of the claims and engage in a 'strong presumption' that claim terms carry their ordinary meaning as viewed by one of ordinary skill in the art."); BJ Servs. Co. v. Halliburton Energy Servs., 338 F.3d 1368, 1372 (Fed. Cir. 2003) ("The question becomes whether one of ordinary skill in the art would understand what is claimed when the claim is read in light of the specification."); Dow Chem. Co. v. Sumitomo Chem. Co., 257 F.3d 1364, 1372 (Fed. Cir. 2001) ("As a starting point, we give claim terms their ordinary and accustomed meaning as understood by one of ordinary skill in the art."). It thus follows as a matter of simple logic that, in the absence of a compelling reason to do otherwise, the written description must also be interpreted according to the understanding of one of ordinary skill in the art.

Taken together, then, one of ordinary skill in the art should be able to read a patent, to discern which matter is disclosed and discussed in the written description, and to recognize which matter has been claimed. "The presumption is, and such is generally the fact, that what is not claimed was not invented by the patentee, but was known and used before he made his invention. But, whether so or not, his own act has made it public property if it was not so before." Mahn v. Harwood, 112 U.S. 354, 361 (1884). The ability to discern both what has been disclosed and what has been claimed is the essence of

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